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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,535	12/31/2003	Stephen Avedis Baratian	19392	5556

7590

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EXAMINER

DAVIS, JENNA L

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/750,535

Applicant(s)

BARATIAN ET AL.

Examiner

Jenna Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-35, 40, 43, 46, 54 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-35, 40, 43, 46, 54 and 57-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. 6.

Claims 1-12, 14-35, 43, 46, 54 and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al. (US 2003/0088228) in view of Uitenbrock (US 2003/0111166 or US 6827806)

Please refer to pages 10-15 of the office action dated 12/30/2005.

Desai et al. disclose an extensible fibrous substrate combined with a plurality of elastomeric members disposed on the substrate (paragraph 10). The substrate is formed from various fibrous materials known to be fluid permeable (paragraph 38). The elastomeric members

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may be applied in a pattern of parallel stripes (paragraph 37), thus allowing the entire composite to remain fluid permeable.

With regard to the claim limitation of an add-on amount of elastomer to be between 2.5 and 100 weight percent, Desai et al. teach the elastomer can be added in amount between 5 and 200 gsm and preferably between 50 and 100 gsm (paragraph 48). Desai et al. also disclose an example wherein the weight of the substrate is 22 gsm (paragraph 107). Using the weight ranges for the amount of elastomer and the weight of the substrate, it is clear that Desai et al. teaches Applicant's claimed range of add-on amount of elastomeric material. In the alternative, the amount of elastomer provided added onto the substrate would affect the degree of elasticity of the final composite. It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide elastomeric stripes in an add-on amount between 2.5 and 100 weight percent of the composite web, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regard to claims 4, 5, 7, 9, and 11, Applicant's limitations of various amounts of elastomer provided upon the substrate demonstrate a lack of criticality as to the amount of elastomeric material needed on the substrate. Therefore, the broad range of elastomeric material added onto the substrate taught by Desai et al. (i.e. between 5 and 200 gsm) is sufficiently specific to anticipate Applicant's claimed narrower ranges, given the lack of criticality. Alternatively, narrowing the range of elastomer provided upon the substrate is simply matter of altering a result effective variable since the amount of elastomer applied to the substrate will directly affect the elasticity of the final product. It would have been obvious to a person having

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ordinary skill in the art at the time of the invention to provide greater amounts of elastomer when a more elastic final product was desired, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215.

With regard to claims 6, 8, 10, 12, and 29 the claimed property of modulus of elasticity is merely a claimed result from the fact that different amounts of elastomer are provided onto the substrate. As set forth above, Desai et al. anticipate or alternatively, render obvious the claimed amounts of elastomeric material on the substrate. Also, Desai et al. teach using the same elastomeric materials, such as KRATON® (paragraph 40), as Applicant teaches in the Specification (see page 11, line 30). Although Desai et al. do not explicitly teach the limitation of modulus of elasticity, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. similar styrene elastomer) and in the similar production steps (i.e. providing the elastomer in similar amounts onto a nonwoven web in a pattern of stripes) used to produce the composite web. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed modulus of elasticities would obviously have been provided by the process disclosed by Desai et al. as a matter of adjusting the result effective variable of the amount of elastomer. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

With regard to claim 14, the 22 gsm substrate taught by Desai et al. (paragraph 107) would equal about 0.6 osy.

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With regard to claims 15, 17, 19, and 21, similar reasoning with respect to claims 4, 5, 7, 9, and 11 rejected above applies. With regard to claims 16, 18, 20, and 22, similar reasoning with respect to claims 6, 8, 10, and 12 rejected above applies.

With regard to claim 23, the substrate may be made from polypropylene (paragraph 28) and may be spunbonded (paragraph 27).

With regard to claims 25-28 and 30, Applicant claims various property values for first cycle hysteresis, second cycle hysteresis, first cycle immediate set, second cycle immediate set, and fluid intake time. However, these property values are merely the result of the claimed product, which has shown to be anticipated by Desai et al. Although Desai et al. do not explicitly teach the limitations of first cycle hysteresis, second cycle hysteresis, first cycle immediate set, second cycle immediate set, and fluid intake time, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. spunbonded polypropylene fabric bonded to a styrene elastomeric layer) and in the similar production steps (i.e. providing the elastomer in similar amounts onto a nonwoven web in a pattern of stripes) used to produce the composite web. The burden is upon the Applicant to prove otherwise. In the alternative, the claimed modulus of elasticities would obviously have been provided by the process disclosed by Desai et al. as a matter of adjusting the result effective variable of the amount of elastomer or by altering the type of fabric used (paragraph 27) or the type of elastomer used (paragraph 40).

With regard to claim 31, Desai et al. disclose using styrene block copolymers (paragraph 40).

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With regard to claim 33, this independent claims recite a combination of limitations already addressed individually above and is anticipated by or alternatively, obvious over Desai et al. for the same reasons. Similar reasoning applies for claims 34 and 35.

With regard to claim 43, Desai et al. teach the elastomeric precursor may be applied by evaporation from a solvent (paragraph 42).

With regard to claim 46, Desai et al. teach the coverage area of the elastomer may be between 10 and 80% (paragraph 48).

With regard to claim 57, Desai et al. teach the elastomer may be coalesced from elastomeric precursors (paragraph 45).

With regard to claims 58 and 59, while each individual stripe may not be fluid permeable, the collection of stripes is fluid permeable as a group because they are spaced apart from one another. Desai et al. do not teach elastomeric strips comprising charged electrospun microfibers or droplets.

The Uitenbrock references teach providing elastomeric adhesive strips –36, 38- to join a topsheet to a coversheet in an absorbent article such as a diaper. The elastomeric adhesive may be an elastomeric latex and the material may be provided by spraying which the examiner equates with the claimed droplets ('116 paragraph [0030] and [0036] '806 column 5, lines 45-56 and column 7, lines 3-22). Desai teaches stretch composites used in diapers, panties, etc. (abstract).

It would have been obvious to a person having ordinary skill in the art at the time the present invention was made to provide the elastomeric strips of Desai as a sprayed-on product

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that would form droplets as Uitenbrock shows such materials to provide elasticity to the products and secure bonding of the topsheet to the backsheet.

Further, "charged electrospun" microfibers or droplets, as recited in claim 1 is a process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The use of 35 USC 102/103 rejections for product-by-process claim has been approved by the courts. "[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products



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by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972).

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desai in view of Uitenbrock '116 or '806 as applied to claim 1 above, and further in view of Mleziva (US 6057024).

The teachings of Desai and the Uitenbrock references are set forth above. Neither reference shows the elastomer being provided in the form of microfibers. As shown by Mleziva it was known in the art of absorbent articles such as diapers to provide elastomeric materials in the form of microfibers. To have provided the elastomeric adhesive of Uitenbrock in the form of microfibers in the product of Desai would have been obvious as the use of a known means for its intended and desired function as taught by Mleziva.

#### ***Response to Arguments***

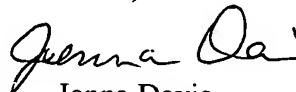
Applicant's arguments with respect to claims 1-12, 14-35, 40, 43, 46, 54, and 57-59 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna Davis whose telephone number is 571-272-3357. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1111. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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